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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/591,480

09/27/2006

Ulrich Kautz

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34375 7590 03/24/2010

NATH & ASSOCIATES PLLC
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Alexandria, VA 22314

EXAMINER

DESAI, RITA J

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

03/24/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/591,480	Applicant(s) KAUTZ, ULRICH	
	Examiner Rita J. Desai	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/26/10</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1-19 have been cancelled.

Claims 20-25 are pending.

Response to the Arguments.

The rejection under 35 USC 112 enablement has been withdrawn as applicants have cancelled the claims 1-19.

The rejection of the claim 1-19 under 35 USC 103 over

WO 99/05113 Gutterer et al

WO 0042020 Flockerzi et al

WO 0042017 Gutterer Beate

WO 9728131 Gutterer et al

WO 2004018431 Flockerzi et al

WO 02/06238 Gutterer et al

WO 2004019945 Kautz et al

WO 2005077906 102(c). (all references are cited on the IDS)

WO02/05616 Bundschuh et al .

WO 99/05111 Amschler et al and

has been withdrawn , but

it is now made over the new claims 20-25 over

WO 99/05113 Gutterer et al

WO 0042020 Flockerzi et al

WO 0042017 Gutterer Beate

WO 9728131 Gutterer et al

WO 2004018431 Flockerzi et al

WO 02/06238 Gutterer et al

WO02/05616 Bundschuh et al .

WO 99/05111 Amschler et al and

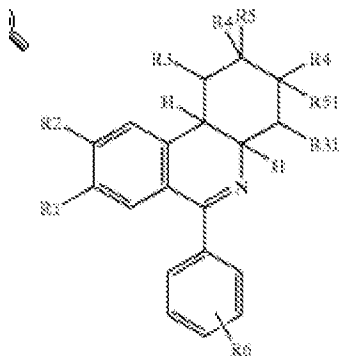
The examiner has added the reference US 6538005 (

cited in the IDS)

Applicants argue the cited reference do not teach each and every element of the claims .

This may be so, however all the elements are taught in the combination of all the references.

Also See US 6538005 Beete Gutterer which teaches the core



. The R2 or R3 can be a OH and R6 is a C=ON- group.

Making this a positional isomer.

In view of the close similarities with all the various references given above . Even though WO 2004/019945 and WO 2005/077906 reference are disqualified under 103(c) rule. The compounds do have a very close structural similarities. The C=O-R7 group is clearly taught. The use of all these compounds is the same. PDE-4 inhibitors and treatment of respiratory and

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allergic disorders. Without any showing of unexpected results it is prima-facie obvious to modify the compounds to obtain the compounds of the invention especially as the het or the alkyl groups for R7 are taught by the prior art.

The rejection of the claims 1-19 under ODP has been withdrawn as the claims have been cancelled, however it is now being made on claims 20-25. for the same reasons as given above.

The examiner is including US 6538005.

USSN 11/581,478

USSN 10/589,082 (also US 2007/0167482)

US 7,329,676

USSN 10/524,820 (now US 7,329,676, cited above)

US 6,121,279

USSN 12/000,710 (also US 2006/0319067).

US 6,127,378

USSN 11/590,803

US 6,191,138

USSN 10/591,472

US 6,410,551

USSN 11/795,981

US 6,476,025

USSN 11/885,423

The claims are all drawn to a similar core and have the same activity. Also see the reasons given in the 103 rejection above. The -OH groups are taught in a different position. The R7 group is also taught. For a person skill in the art of drug Design such as the applicants, the very close similarity in the structure in the prior art and with all the variable taught but with the OH at a different location, would be motivated to make the change and modify the compounds, with a predictable expectation of success the the compounds would have the same activity.

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Applicants have no data to show any unexpected results due to the –OH at the specific position nor for the R7 group.

Thus in the absence of any showing the claims are rendered obvious over the other documents.

Claim Objections

Claims 20-25 are objected to because of the following informalities: These claims refer to a figure with R groups and then the claim is drawn to species only. Thus there no definition of the R groups in the claims itself even though the species do that specific substitutions only. This is confusing and appropriate correction is required. (suggestion :-delete the formula from the claim.)

Conclusion

Claims 20-25 are rejected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, flex time..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rita J. Desai/
Primary Examiner, Art Unit 1625

March 22, 2010 .

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